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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/811,498	03/29/2004	Gerald Duhamel	P1025US01	8902
77130 7590 09/21/2010 LABTRONIX CONCEPT C/O BENOIT & COTE, s.e.n.c. 1001, DE MAISONNEUVE BOULEVARD WEST SUITE 210 MONTREAL, QC H3A 3C8 CANADA				
EXAMINER SAGER, MARK ALAN				
ART UNIT 3714		PAPER NUMBER		
NOTIFICATION DATE 09/21/2010		DELIVERY MODE ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

docket@benoit-cote.com  
docket.bc@gmail.com

# Office Action Summary

**Application No.**

10/811,498

**Applicant(s)**

DUHAMEL ET AL.

**Examiner**

M. Sager

**Art Unit**

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 August 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/CD)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

***Claim Interpretation***

1. Per MPEP 2111.04, claim scope is not limited by claim language that suggests or makes optional but does not require steps to be performed, or by claim language that does not limit a claim to a particular structure. However, examples of claim language, although not exhaustive, that may raise a question as to the limiting effect of the language in a claim are (A) “adapted to” or “adapted for” clauses, (B) “wherein” clauses, and (C) “whereby” clauses. The determination of whether each of these clauses is a limitation in a claim depends on the specific facts of the case. In *Hoffer v. Microsoft Corp.*, 405 F.3d 1326, 1329, 74 USPQ2d 1481, 1483 (Fed. Cir. 2005), the court held that when a “whereby” clause states a condition that is material to patentability, it cannot be ignored in order to change the substance of the invention.” *Id.* However, the court noted (quoting *Minton v. Nat’l Ass’n of Securities Dealers, Inc.*, 336 F.3d 1373, 1381, 67 USPQ2d 1614, 1620 (Fed. Cir. 2003)) that a “whereby clause in a method claim is not given weight when it simply expresses the intended result of a process step positively recited.”” *Id.*
2. Per MPEP 2114, while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. In *re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997) (The absence of a disclosure in a prior art reference relating to function did not defeat the Board’s finding of anticipation of claimed apparatus because the limitations at issue were found to be inherent in the prior art reference); see also *In re Swinehart*, 439 F.2d 210, 212-13, 169 USPQ 226, 228-29 (CCPA 1971); *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). “[A]pparatus claims cover what a device *is*, not what a device *does*.”

*Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original).

***Claim Rejections - 35 USC § 102***

3. Claims 1-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Bennett (6056642). This holding is maintained from prior action incorporated herein as copied below for cited claims as amended. Response to remarks is provided below and incorporated herein.

Where disclosed/claimed evolving symbol includes a color changing symbol per paragraph 27, Bennett discloses a method of operating a game being provided on a gaming machine, a gaming apparatus and a computer program embodied on a computer readable medium or memory having codes adapted to when executed by a computer cause computer to perform the claimed functions (abstract, 2:27-3:2, figs 1-3) including displaying on the gaming machine a line game comprising symbols organized according to a line game structure (abstract, 2:27-3:2, 3:23-38, figs 1-3), operating a meter as at least three different statuses of an evolving symbol that evolves from a clear 7 symbol to colored red, blue or white or any combination thereof and pays an award as jackpot or a portion of jackpot (abstract, 2:27-3:2, 3:27-4:32, figs 1-3) said evolving symbol being part of said symbols organized according to said line game structure (abstract, 2:27-3:2, 3:27-4:32, figs 1-3), triggering a feature on the gaming machine based on at least one of said statuses as jackpot or portion thereof for particular status of evolving symbols (abstract, 2:27-3:2, 3:27-4:32, figs 1-3), where evolving symbols occur on a reel, each occurrence of evolving symbol comprising an ESU (abstract, 2:27-3:2, 3:27-4:32, figs 1-3), wherein all ESUs evolve upon occurrence of an evolution trigger such as when the three 7s evolve to red, blue or white 7 symbols (abstract, 2:27-3:2, 3:27-4:32, figs 1-3), occurs when the meter reaches a predetermined

threshold of three 7 symbols on pay line including only a portion evolve upon occurrence of an evolution trigger where only a portion fails to preclude all (abstract, 2:27-3:2, 3:27-4:32, figs 1-3), wherein the evolution trigger occurs when the meter reaches a predetermined threshold of three 7 symbols on pay line (supra), wherein the number of evolving ESUs is randomly selected per displayed game outcome (supra), wherein the ESUs evolve at same rate such that upon occurrence of three 7 symbols on pay line each symbol evolves to either red, blue or white at same time (as best understood there is no delay between respective reels), wherein each evolving ESU evolves independently such that each 7 symbol on pay line evolves independently (as best understood there is no dependence between displayed symbols on reels to evolve), where a meter gathers occurrences of a predetermined event as a number of 7s on a pay line, a display controller (abstract, 2:27-3:2, 3:27-4:32, fig 1-3, esp. fig 2-3) displaying a line game comprising symbols organized according to a line game structure (supra) and said meter as at least three different statuses of an evolving symbol part of said symbols organized according to said game structure (abstract, 2:27-3:2, 3:27-4:32, figs 2-3) and an evaluation means (ref 30) triggering a feature in said line game based on at least one of said statuses as a jackpot or portion thereof (supra).

#### ***Response to Arguments***

4. Applicant's arguments, see page 6, filed Aug 10, 2010, with respect to 101 have been fully considered and are persuasive. The rejection of claim 19 has been withdrawn.
5. Applicant's arguments, see remarks page 6, filed Aug 10, 2010, with respect to 112(1) have been fully considered and are persuasive. The rejection of claims 2-4 and 15-17 has been withdrawn.

6. Applicant's arguments filed Aug 10, 2010 have been fully considered but they are not persuasive. The Applicant states on pages 6-9 that there is no mention of a meter, counter or any suggestion or notion of gathering occurrences of any event in and around the game and that by definition, the limitation 'operating a meter' involves measuring something, not simply indicating the result of an outcome as in Bennett, the Office disagrees and notes that only claims 2-4 and 16 contain a limitation containing 'to gather occurrences' where previously the listing was inclusive but presently is amended to be exclusive resultant by replacing 'and' with 'or' that thereby previously required a meter to track multiple statuses for multiple elements [a one to many relationship] being gathered but now regards a meter to track multiple statuses for an element [a one to one relationship] and thus Bennett was not applied against those claims due to the inclusionary term. The Office disagrees that the other pending claims as implied by remarks on page 8 that they also claim to gather occurrences since as would have been interpreted by an artisan the claims include or at least fail to preclude indicating a result of multiple occurrences of a symbol that morphs by color changing to indicate a different state so as to inform player regarding status or prize level as taught by Bennett. The present exclusionary language in claim 2-4 and 16 for use of 'or' fails to preclude teachings of Bennett that gathers a occurrences of a symbol or a combination of symbols as a number of 7's that are transformed to indicate status or prize level where the particular number of occurrences of particular colored 7 is the measure that denotes prize level such as all white, all blue, all red or mixture thereof as stated therein). It is noted claim 15 as amended is taught by Bennett due to different state transforms prize level to a different symbol prize value; while claim 16 is combined claims 2-4. The Office agrees with stated definition of a meter and to evolve on page 8 and that the purpose of Bennett stated on

page 6-7 was to increase the number of symbols displayable by adding states to particular symbol or symbol combination but disagrees that the definitions precludes teaching of Bennett since evidence shows scope of operating a meter displayed as changing, morphing or evolving a symbol or combination of symbols of at least three different statuses of an evolving symbol or combination of symbols as taught by Bennett similarly is defined in instant disclosure at paragraph 27 noted in holding that demonstrates to an artisan that Bennett discloses same structure performing same functions contrary to allegations presented.

Finally, present claims do not require sustaining an accumulated indication to a subsequent play in manner to preclude Bennett as implied in arguments on page 8 since a meter to provide an indication of a measure of statuses of a symbol or a combination of symbols to inform player regarding their state of play such as prize level is taught by Bennett and is included by scope of present invention, but the present meter is not defined to be sustain its display of statuses across multiple game plays. However, art in record and previously applied such as Walker [as well as others] teach storing an accumulated value of gathered occurrences of a symbol. The Office would consider such combination of Bennett with Walker [or another similar reference] for their teachings as a whole if claims were amended to specifically define a temporal sustainment of count tracked by the meter.

### ***Conclusion***

7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. **THIS ACTION IS MADE FINAL**. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.



10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. Sager whose telephone number is 571-272-4454. The examiner can normally be reached on T-F, 0700-1730 hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on 571-272-4690. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. Sager/  
Primary Examiner, Art Unit 3714